



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/574,294

03/31/2006

Hiroshi Hochi

06156/LH

7049

1933 7590 05/07/2009

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
220 Fifth Avenue
16TH Floor
NEW YORK, NY 10001-7708

EXAMINER

STEITZ, RACHEL RUNNING

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

05/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,294	Applicant(s) HOCHI, HIROSHI	
	Examiner Rachel R. Steitz	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/19/09; 3/17/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 17, 2009 has been entered.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4-11 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finamore (US 4,456,019).

Regarding claim 4, Finamore discloses a base (12) formed of a thin sheet having a thickness, hair segments (30) are implanted onto the base and have root portions protruding from an underside of the base (see Figure 7; column 2, 25-30). An adhesive layer (35) is formed on an entirety of the underside of the base with a uniform thickness, the adhesive layer further comprises projected portions which engage the root portions of the implanted hair segments protruding from the underside of the base and the

Art Unit: 3732

remaining portions and the projected portions become reversed and are raised toward a surface side of the base when the wig is fitted onto a human skin (see Figure 6; column 3, lines 65-70). Regarding claim 6, an adhesive (38) is applied in a dotted pattern to the root portions of the implanted hair segments (see Figure 6; column 3, lines 65-70).

Regarding claim 7, the base (12) is made from a transparent material (column 3, lines 40-45). Regarding claim 8, the material of the base comprises polyurethane (column 2, lines 25-30). Regarding claim 9, the base (12) is formed as substantially a flat sheet (see Figure 6). Regarding claim 11, the adhesive layer (35) comprises an acryl-based adhesive (column 4, lines 8-12). Regarding 14, the base (12) is deformed into a substantially rugged sheet when the wig is fitted onto the human skin (see Figure 6).

Regarding claim 16, when the wig is not fitted onto the human skin an underside of the adhesive layer which is formed on the entire underside of the base is substantially rugged (see Figure 6). Regarding 17, when the wig is fitted onto the human skin an underside of the adhesive layer which is formed on the underside of the base becomes substantially flat (see Figure 8).

Regarding claim 4, Finamore does not disclose the base being formed from an elastic thin sheet having a thickness on the order of microns and the uniform thickness of the adhesive layer being in a range of up to about 20 times greater than the thickness of said base. Finamore does disclose the sheet being an extremely thin, flexible and transparent (column 1, lines 50-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the flexible sheet of Finamore be made from elastic, since it has been held to be within the general skill of a worker in

Art Unit: 3732

the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the thickness be on the order of microns and the uniform thickness of the adhesive layer be in the range of up to about 20 times greater than the thickness of the base, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. Further applicant has not defined what the order of microns is referring too, any thickness can be written in the order of microns.

Regarding claim 5, Finamore does not disclose the projected portions of the adhesive layer having a height of about 80 microns. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the projected portions of the adhesive layer have a height of about 80 microns, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 10, Finamore does not disclose the hair segments being a polyester fiber. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the hair segments be polyester fiber, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding 15, Finamore does not disclose the uniform thickness of the adhesive layer and a height of the projected portions being on the order of microns. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the uniform thickness of the adhesive layer and the height fo the projected portions be on the order of microns, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

3. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finamore (US 4,456,019) in view of Ra (US 2001/0037813).

Finamore discloses a double-sided adhesive (column 4, lines 57-60), however, Finamore does not disclose a first and second release paper, one adhered to the skin side and one adhered to the base side adhesive.

Ra teaches using a release paper (21) to cover an adhesive. Regarding claims 12 and 13, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the double-sided adhesive of Finamore with a first and second release paper as taught by Ra in order to protect the tacky adhesive prior to use.

Response to Arguments

4. Applicant's arguments filed March 17, 2009 have been fully considered but they are not persuasive.

Art Unit: 3732

5. In response to applicants argument that Finamore does not disclose a wig that is disposable, however, claims are given their broadest reasonable interpretation and "disposable" is interpreted as designed for or capable of being thrown away after being used or used up, Finamore meets this limitation because after the hairpiece has been used up the user is capable of throwing the hairpiece away.

6. In response to applicants argument that Finamore's hair piece is custom-shaped and therefore does not meet the limitation "non-customized", however, even if the hairpiece is made to fit a specific user there is nothing precluding another user from wearing the hairpiece, further it is unclear to the examiner where Finamore states that the hairpiece can only be worn by one user.

7. In response to applicant's argument that Finamore does not disclose an elastic base, however, Finamore does disclose that the base is extremely thin and flexible (column 1, lines 50-55), therefore, one having ordinary skill in the art would be able to substitute the polyester-based thermoplastic polyurethane film for an elastic material because they both provide flexibility.

8. In response to applicant's argument that Finamore does not disclose an adhesive layer which is formed on an entirety of the underside of the base with a uniform thickness, however, Finamore does disclose an adhesive layer (38) which is formed on an entirety of the underside of the base with a uniform thickness (column 3, lines 65-70 and column 4, lines 1-5).

9. In response to applicant's argument that the base is on the order to microns and the base of Finamore is in millimeters, however, being on the order of microns is very

Art Unit: 3732

broad term since applicant has not provided a range of microns, therefore, Finamore discloses that the base is about 10 mils which is 254 microns so Finamore is on the order of microns.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel R. Steitz whose telephone number is (571)272-1917. The examiner can normally be reached on Monday-Friday 7:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/
Primary Examiner, Art Unit 3732

/Rachel Running Steitz/
Examiner
Art Unit 3732

Application/Control Number: 10/574,294
Art Unit: 3732

Page 8